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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92062555
Party	Plaintiff Sweet P's Barbeque & Soul House, LLC
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Date	07/06/2016
Attachments	7081200-topto-20160706-joint motion.pdf(870782 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark Registration No.: 4,786,688
For the mark: SWEET PEA'S
Date registered: August 4, 2015

SWEET P'S BARBEQUE & SOUL HOUSE, LLC,)	
)	
Petitioner,)	
v.)	
)	Cancellation: 92062555
)	
PAUL DZUBNAR,)	
)	
Respondent.)	

JOINT MOTION TO UNSUSPEND THE CANCELLATION PROCEEDING, CONVERT THE
CANCELLATION PROCEEDING TO A CONCURRENT USE PROCEEDING, AND TO
ACCEPT THE PARTIES' CONCURRENT USE AGREEMENT

The parties, by and through counsel, hereby jointly move to unsuspend the Cancellation Proceeding, convert this Cancellation Proceeding to a concurrent use proceeding, and approve the parties' Concurrent Use Agreement (the "Motion").

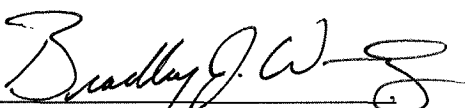
Pursuant to TBMP § 1113.02, a cancellation proceeding may be terminated in favor of a concurrent use proceeding if one party has a concurrent use application reciting the adverse party in the cancellation proceeding as an exception to its claim of exclusive use; the application is published in the Official Gazette for opposition; and no opposition is filed.

On March 7, 2016, Sweet P's Barbeque & Soul House, LLC ("Petitioner") voluntarily amended its pending application for SWEET P's (Application Serial No. 86692033) to one for concurrent use identifying Paul Dzubnar ("Respondent") as an exception to its claim of exclusive use. Petitioner's SWEET P'S mark was published for opposition on May 31, 2016, and no opposition was filed to the registration of Petitioner's SWEET P'S mark. Therefore, under the circumstances, it is appropriate to convert the Cancellation Proceeding to a Concurrent Use proceeding.

On February 29, 2016, the parties entered into a Settlement Agreement that included an agreed upon territorial division of the United States. Attached as Exhibit A, is a true and correct copy of the parties' Settlement Agreement. The parties agreed to use their respective marks only in their defined geographic territory, to take appropriate precautions to prevent consumer confusion from occurring, and to work together to abate any confusion that may occur. The parties believe the terms of their Settlement Agreement are sufficient to avoid confusion, mistake, or deception by their respective concurrent use of their marks.

Therefore, the parties respectfully request that the Board grant the Motion and order the issuance of Concurrent Use Registrations to Petitioner and Respondent consistent with the terms of the parties' Settlement Agreement.

WINTHROP & WEINSTINE, P.A.


By: 
Bradley J. Walz
3500 Capella Tower
225 South Sixth Street
Minneapolis, MN 55402
(612) 604-6400

Dated: July 6, 2016

ATTORNEYS FOR RESPONDENT

Respectfully submitted,

LUEDEKA NEELY GROUP, P.C.

By: 
Robert O. Fox
Reg. No. 34,165
1504 Riverview Tower
Knoxville, TN 37902
(865) 546-4305

Dated: July 5, 2016

ATTORNEYS FOR PETITIONER

EXHIBIT A

SETTLEMENT AGREEMENT

THIS SETTLEMENT AGREEMENT (“Agreement”), effective as of the date the last Party signs this Agreement (the “Effective Date”), is entered into by and between Sweet P’s Barbeque & Soul House, LLC, a Tennessee limited liability company, having a principal place of business at 4815 Kingston Pike PMB 170, Knoxville, TN 37919 (“Sweet P’s”) and Paul Dzubnar, an individual, having a residence at 2150 Bayard Avenue, St. Paul, MN 55116 (collectively the “Parties” and individually a “Party”).

WHEREAS, Mr. Dzubnar is the record owner of a service mark registration for SWEET PEA’S in connection with “bar and restaurant services” (the “SWEET PEA’S Mark”); namely, Reg. No. 4,786,688 (the “SWEET PEA’S Registration”);

WHEREAS, Sweet P’s is the record owner of Application Serial No. 86/692,033 (the “SWEET P’S Application”) for the mark SWEET P’S in connection with “restaurant and catering services” (the “SWEET P’S Mark”);

WHEREAS, Sweet P’s claimed date of first use for the SWEET P’S Mark is January 1, 2006 and Mr. Dzubnar’s claimed date of first use for the SWEET PEA’S Mark is June 2, 2014;

WHEREAS, Sweet P’s objected to the continued registration of the SWEET PEA’S Mark, and filed a Petition to Cancel the SWEET PEA’S Registration, which was assigned Cancellation No. 92062555 by the Trademark Trial and Appeal Board (the “Board”) (the “Cancellation Proceeding”); and

WHEREAS, the Parties wish to settle and resolve the Cancellation Proceeding without having to incur further legal costs and expenses.

NOW, THEREFORE, in consideration of the above premises, which are expressly incorporated into and a part of this Agreement, and the mutual covenants contained herein the Parties agree as follows:

1. The Parties agree to the following territorial division of the United States and agree to use their respective marks only in the following territories:

For Sweet P’s: Colorado, Kansas, Missouri, Illinois, Indiana, Ohio, West Virginia, Virginia, Kentucky, Tennessee, North Carolina, South Carolina, Georgia, Florida, Alabama, Mississippi, Arkansas, Louisiana, Texas, Oklahoma, and New Mexico (collectively the “Sweet P’s Territory”).

For Mr. Dzubnar: Washington, Idaho, Montana, North Dakota, South Dakota, Minnesota, Wisconsin, Michigan, Pennsylvania, New York, Vermont, New Hampshire, Maine, Massachusetts, Rhode Island, Connecticut, New Jersey, Delaware, Maryland, Iowa, Nebraska, Wyoming, Utah, Arizona, California, Nevada, Oregon, Alaska, and Hawaii (collectively the “Dzubnar Territory”).

2. The Parties to date are not aware of any incidence of consumer confusion. The Parties agree to take all appropriate precautions to prevent consumer confusion by the use of their respective marks, and in the event evidence of actual confusion should arise, the Parties will negotiate in good faith and make appropriate adjustments with regard to the advertising and use of their marks to eliminate the confusion. In particular the parties have and will also utilize logos and trade dress that are distinctively different from one another.
3. In the reasonable exercise of their business judgment and after due deliberation of the relevant facts, Sweet P's consents to the continued registration of the SWEET PEA'S Mark with the geographic restriction agreed to in Section 1 of this Agreement and Mr. Dzubnar consents to the registration of the SWEET P'S Mark with the geographic restriction agreed to in Section 1 of this Agreement.
4. Within seven calendar days of the Effective Date, Sweet P's will request to unsuspend the SWEET P'S Application and will request to amend its current filing basis to one for concurrent use. During the examination of the amendment to the SWEET P'S Application, the Parties agree to suspend the Cancellation Proceeding. Within seven calendar days of the expiration of the opposition period for the SWEET P'S Application, the Parties agree to jointly move the Board to convert the Cancellation Proceeding to a Concurrent Use Proceeding.
5. Contingent upon the granting of the sought concurrent use registrations for the Parties, Sweet P's agrees not to contest or otherwise challenge the use or registration of the SWEET PEA'S Mark in the Dzubnar Territory, and will not, directly or indirectly, aid or assist any other persons or entities in challenging the ownership, validity, and use of the SWEET PEA'S Mark in the Dzubnar Territory.
6. Contingent upon the granting of the sought concurrent use registrations for the Parties, Mr. Dzubnar agrees not to contest or otherwise challenge the use or registration of the SWEET P'S Mark in the Sweet P's Territory, and will not, directly or indirectly, aid or assist any other persons or entities in challenging the ownership, validity, and use of the SWEET P'S Mark in the Sweet P's Territory.
7. If either Party commits a material breach of this Agreement, then the breaching Party will have 30 calendar days to cure the breach calculated from the date the breaching Party receives written notice from the nonbreaching Party specifying the nature of the breach. For the purpose of this Agreement, an alleged breach is deemed to be "cured" if the nonbreaching Party agrees in writing that the alleged breach has been cured. The Parties agree that acknowledging the cure of an alleged breach will not be unreasonably withheld. In the event that the breaching party fails to cure an alleged breach and the nonbreaching Party is compelled to enforce the terms of this Agreement, the prevailing party is entitled to recover, in addition to statutory costs of litigation, its costs to enforce the terms of this Agreement including, without limitation, all attorneys' fees, investigation costs, and appeal costs.

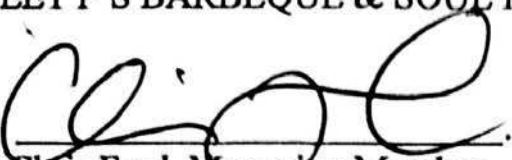
8. This Agreement constitutes the entire agreement and understanding between the Parties and supersedes and replaces all prior agreements and understandings between and among the Parties. This Agreement will not be modified or amended, in any way, unless through written instrument executed by the Parties.
9. This Agreement is binding upon, and inures to the benefit of, the Parties and their respective successors and assigns, officers, directors, shareholders, agents, attorneys, subsidiaries, parent corporations, affiliates, successors in interest, successors through merger or corporate restructure, and successors through a sale of all or substantially all of the assets or business, and anyone else acting on their behalf.
10. This Agreement may be executed in any number of counterparts, each of which when executed and delivered is an original, but all such counterparts will constitute one and the same instrument. Delivery of a copy of this Agreement executed by a Party, including by fax or e-mail, has the same force and effect as personal delivery by such Party of an executed paper original of this Agreement.
11. If any provision of this Agreement is held invalid or unenforceable, such determination will not affect the remaining portions of this Agreement, and the affected provisions must be interpreted and enforced to the full extent possible to carry out the intent of such provision.
12. Failure to enforce this Agreement will not be a waiver of any provision of this Agreement, and a waiver of breach will not be a waiver of any other or subsequent breach.
13. The Parties represent that each has the full and necessary authority to enter into this Agreement and that the individual executing this Agreement has full authority to bind the Parties, as the case may be, to all terms and conditions of this Agreement, and that the Parties are each fully capable of performing all terms and conditions of this Agreement.
14. The Parties acknowledge that they have been represented by their own legal counsel, have thoroughly read and understand the terms of this Agreement, and are voluntarily entering into this Agreement to resolve their respective claims and objections.
15. The Parties acknowledge and agree that any statute or rule of construction providing that ambiguities are to be resolved against the drafting Party does not apply to the interpretation of this Agreement.

[THE SIGNATURE PAGE FOLLOWS]

IN WITNESS WHEREOF, the Parties have executed this Agreement on the dates written below.

SWEET P'S BARBEQUE & SOUL HOUSE, LLC

By:


Chris Ford, Managing Member

Date: February 29, 2016

PAUL DZUBNAR



Date: February 29, 2016